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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,986	12/21/1999	AKIHIKO NAKAZAWA	35.C14120	3093

5514 7590 04/18/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS16

Office Action Summary	Applicati n No.	Applicant(s)	
	09/467,986	NAKAZAWA ET AL.	
	Examin r	Art Unit	
	Lawrence D Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,9-13 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,9-13 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed February 4, 2003.
Claims 8, 14-16, 18 and 21-27 were canceled and claims 1 and 30 were amended, rendering claims 1-3, 5, 9-13 and 30 pending.

Claim Rejections – 35 USC 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 9-13 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sypula et al. (U.S. 5,525,446) in view of Mitsubishi (JP 4255332) for the reasons set forth in paragraph 2, in the previous office action, mailed September 27, 2002. Regarding newly added limitation to claims 1 and 30, 'external diameter of from 105% to 400%' the prior art of Sypula et al. (U.S. 5,525,446) in view of Mitsubishi (JP 4255332) meets such limitation as indicated in previous rejection(s), in that the present amendment is set forth based on canceled claim 8 of the instantly claimed invention.

12/22/98

Response to Arguments

4. Examiner acknowledges the cancellation of claims 8, 14-16, 18 and 21-27. Applicant's arguments to 35 USC 103(a) being unpatentable over Sypula et al. (U.S. 5,525,446) in view of Mitsubishi (JP 4255332) have been fully considered but are unpersuasive. Applicant argues Sypula is directed to a method of producing an endless belt using a circular die, where the reference states that 'polysulfone' and polyethersulfone' are suitable resins. However, Sypula does not disclose or suggest any specifics regarding the physical properties of the extrusion material as defined in the present claims. This is not true because Sypula discloses the member can be in the form of an endless belt (column 2, lines 55-56) comprising polycarbonate resins employed as the bottom layer of the intermediate transfer member (column 2, lines 62-63) including 4,4'-dihydroxy-diphenyl-sulphone and the like (column 3, lines 14-15). Sypula has many specifics regarding the physical properties of the extrusion material as defined in the present claims. Applicant further argues even when a resin in Sypula bears the same name as the resin in the subject application, a skilled artisan would readily understand that these resins do not necessarily have the same physical properties depending upon a variation in their molecular weights or the amount of additive used. This argument is unpersuasive because Applicant has presented no showing that Sypula cannot show the claimed features. Applicant argues it would not be possible to glean the physical properties of the extrusion material in Sypula only from the mere names 'polysulfone' and 'polyethersulfone'. The physical properties are not obvious solely based on the polysulfone and polyethersulfone. The external diameter

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and breaking extension and strength are directly related to the extrusion material used and directly affect the durability of the endless belt. Since the references use the same endless belt (column 2, lines 55-56) comprising a melt extruded thermoplastic film (column 3, lines 16-18), the external diameter and breaking extension and strength would be expected to be the same as applicant claims, absent any showing of unexpected results.

Applicant argues Sympula does not disclose or suggest any dimensional relationships in connection with the external diameter of the endless belt and the die slit and does not provide any examples of using the inflation extrusion forming method. As earlier indicated, because the references use the same endless belt (column 2, lines 55-56) comprising a melt extruded thermoplastic film (column 3, lines 16-18), the external diameter would be expected to be the same as applicant claims, absent any showing of unexpected results. Furthermore, an inflation extrusion forming method is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Applicant argues the parameters were not indicated as result effective in order to be deemed optimizable. As earlier indicated, the external diameter and breaking extension and strength are directly

related to the extrusion material used and directly affect the durability of the endless belt.

Applicant argues Sypula does not suggest that the resin is specifically suitable for the melt-extruded belt. This is not true because Sypula discloses polycarbonate resins employed as the bottom layer of the intermediate transfer member (column 2, lines 62-63) including 4,4'-dihydroxy-diphenyl-sulphone and the like (column 3, lines 14-15). Applicant points to comparative example 1 in the instant application to show a belt that has a tensile breaking strength outside the presently claimed range; however, this example merely shows that particular resin having a specifically different tensile breaking strength does not show the same properties. This example does not overcome the rejection of Sypula. Applicant has not shown that the Sypula reference endless belt cannot show this feature.

Applicant argues Mitsubishi cannot cure the deficiencies of Sypula. Because Sypula has been maintained, Mitsubishi is also maintained. Applicant argues Mitsubishi does not contain any teaching regarding the physical properties of the extrusion material as presently claimed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references and has an external diameter smaller than that of the die slit. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mitsubishi merely teaches the conventionality of circular dies in extruders.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

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After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774



ELIZABETH MULVANEY
PRIMARY EXAMINER